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09/622,001	09/22/2000	Yasutaka Ishii	3273-0121P	5966

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT PAPER NUMBER

1626

DATE MAILED: 07/22/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/622,001
Filing Date: September 22, 2000
Appellant(s): ISHII ET AL.

Birch, Stewart, Kolasch & Birch, LLP
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/6/05.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3 and 21 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3 and 21 are rejected under 35 U.S.C. 112, first and second paragraphs. This rejection is set forth in a prior Office Action, mailed on 12/6/04.

(11) Response to Argument

Summary of Claimed Subject Matter

Applicant argues that the significance of the instant invention is the provision of a class of imide catalysts useful in certain classes of reactions. This is not persuasive because the claims are not drawn to the catalyst but to processes of making organic compounds. The catalyst is known and described in many prior arts (IFW scanned NPL as REM, 9/16/04) submitted by applicant on 9/16/04. Applicant also contends he has provided "voluminous generic disclosure and working examples" in the specification. This is not persuasive because applicant is asking the Examiner to read the specification into the claims. On the contrary, a claim must stand alone to define the invention.

35 USC 112, second paragraph

Applicant contends that 35 USC 112, 2nd does not require recitation of specific reagent or product but rather what applicant intends. This is not persuasive because 35 USC 112, 2nd requires a claim to be clear, distinct and particularly points out the invention. In the instant claims, the reagents and products are not sufficiently identified and therefore, are not clear or distinct. Under 35 USC 8, MPEP 903, each claim must be classified, and in a process claim the classification is determined by the product. "Organic compound" is not a sufficient identity of a compound. It is analogous to saying "automobile" or "vehicle" is the same as "Toyota Camry", Infinity QX4 SUV "Ford Trailer", etc.

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Applicant argues that the court in *In re Fischer*, 166 USPQ 81, did not find "polypeptide of at least 24 amino acids" indefinite. The decision is based on the fact that polypeptide is a sub-generic name and is further defined by the first 24 amino acids from the N-terminal. The specific 24 amino acids were identified, and their sequence was identified. In the instant claims, the reagents and products are not sufficiently identified either by name or structure.

Applicant also argues that under *In re Skoll*, 197 USPQ 481, "water soluble hydrolyzed carbohydrate is acceptable because it was adequately defined in the specification." This is not persuasive because applicant fails to point out in the specification where "organic group", "organic compound", etc. are adequately defined in the specification. Applicant also contends that the same court found "organic and inorganic acids" definite. This argument is not analogous to the instant claims because all specific organic and inorganic acids are well known in the art.

Applicant further contends that in *In re Mercier*, 185 USPQ 774, "a fluidized catalyst" was not found indefinite. This is not persuasive because the catalyst in *In re Mercier*, is further identified in the claim as "a sulfonic ion exchange resin in acid form".

Applicant concluded that it can be readily determined if a particular process for addition or substitution reaction product is within the scope of claims 1, 3 and 21. This is not persuasive because the process of making such determination would constitute undue burden since one of ordinary skill in the art would have to try all known "carbonyl-containing compounds", all "unsaturated compounds", all metallic co-catalysts, etc. to determine which ones are applicable in order to practice the claims as written.

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35 USC 112, first paragraph

Wands factors 1 and 2: Applicant contends that the invention relates to only "organic compounds that are addition or substitution reaction products of a compound A and a compound B, and that both compounds A and B are defined in the claims. This is not persuasive because compounds A and B are not defined in the specification and claims with sufficient distinction as required under 35 USC 112.

Wands factor 3: Applicant argues that relevant background arts are discussed on pages 2-6 of the specification. This is not persuasive because while the arts discussed various reactions involving specific reagents for making specific compounds the instant claims are drawn to the making of nonspecific compounds from non-specific reagents, e.g. unsaturated hydrocarbons and/or compounds.

Wands factor 4: Applicant ask for additional explanation of the following:

The level of ordinary skill in the art is limited to a process of making α -hydroxy- γ,γ -dimethyl- γ -butyrolactone as disclosed in the specification. This means the level of skill in the art is limited to what is disclosed in the specification for making α -hydroxy- γ,γ -dimethyl- γ -butyrolactone. The level of skill in the art is not high in making compounds using the non-specific reagents to make non-specific products, wherein the substituents (organic groups or organic hydrocarbons) embrace the entire textbook of organic chemistry.

Wands factors 5, 6 and 7: Applicant contends that "a high degree of predictability is inherent in the invention. This is not true because practicing the claims would constitutes a serious and undue burden since one of ordinary skill in the art would have to try all known "carbonyl-containing compounds", all "unsaturated compounds", metallic co-catalysts, etc. to determine which ones are applicable in the instant claims. The relevant examples in the

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specification are not sufficient to guide one of ordinary skill in the art to practice the instant claims without this undue burden.

Wands factor 8: Applicant argues that the instant invention does not lend itself to undue experimentation and that the claims are enabled. This is not persuasive because the claims do lend themselves to undue experimentation for reasons set forth above under factors 5, 6 and 7.

In referring to the 2.8 % yield in *Wands*, applicant clearly misses the point because having to perform an enabled or simple experiment and obtain a low yield is different from having to go through undue experimentation with low or high yield.

Applicant asked if only the 38 examples in the specification are enabled. No, because applicant made an election and only the relevant example to the elected process is considered, not all the 38 examples. In considering the relevant example, the examiner noted that substituents such as H, OH, etc. in examples R3 (IFW REM, 9/16/04) are described in the specification and the claims as organic groups, organic hydrocarbons, thereby obliterating the identities of the reagents as well as the products.

35 USC 101: The rejection is hereby withdrawn.

Conclusion

Applicant did himself a disservice by obliterating the identities of the reagents and the products. Under 35 USC 8, MPEP 903, all claims must be classified. The class and subclass(es) must be searched to determine patentability. It is mandatory under the US patent practice that every allowed claim be classified. MPEP 904. In a claim drawn to a process of making, the product determines the classification. In the instant invention, the product is not identifiable: structurally or by any other means. While the statute may not require applicant to

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draft a claim in terms pertinent to the USPTO classification system, applicant should note that the Examiner needs not allow such a claim because the Office must perform its duty in conformance with 35 USC 8 and other relevant statutes. Applicant again misses the point by asserting the instant invention relates to using a catalyst for making certain compounds. Applicant's claims are not drawn to the catalyst, the catalyst is well known and its utility is also well known,

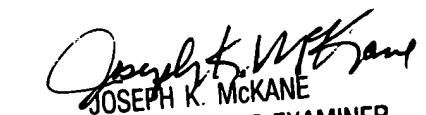
In conclusion, applicant's claims are not sufficiently supported by the specification as required under 35 USC 112, first paragraph and are not clear or distinct as required by the second paragraph. The claims are not classifiable as required under 35 USC 8. Therefore, the claims are not patentable.



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